

Atty. Docket No. YOR920030045US1
(590.104)

REMARKS

Please note the fact that January 22, 2006, fell on a Sunday ensures this paper is timely filed as of the next business day, Monday, January 23, 2006. Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

In the prior Office Action a three way restriction requirement was imposed, which was traversed by the Applicants. In the outstanding Office Action the restriction requirement was made final, the Office stating "this application contains multiple inventions. Therefore, any searching or consideration beyond that of the scope of one invention would be deemed burdensome." (*Office Action* at 2) Reconsideration is respectfully requested, as the basis for the restriction requirement (set forth above) is circular in nature and is improper under MPEP § ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions").

Furthermore, the Office has failed to establish a prima facie face of undue burden and has failed to address the comments made by Applicants in the last response regarding same. As noted therein, that there may be separate inventions in an application does not by itself mean a restriction requirement is proper. See MPEP § 904.02(a) ("In outlining a field of search, the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature that may have material pertinent to the subject matter as claimed. Every subclass, digest, and cross-reference art

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collection pertinent to each type of invention claimed should be included, from the largest combination through the various subcombinations to the most elementary part. The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.”). In this regard, the Office’s attention is directed to two of numerous similar U.S. Patents, Patent No. 6,858,909 which issued on February 22, 2005 and is assigned to the assignee of the present invention (International Business Machines Corporation), and U.S. Patent No. 6,600,202 which issued on July 29, 2003 and is assigned to Wolff Controls Corporation. These recently issued U.S. Patents were searched in multiple classes and classified in multiple classes; in fact, the multiple classes for searching and classification include the three class/subclasses identified in the prior Restriction Requirement. In view of this past Office practice, there can be no credible assertion there would be a serious burden in searching and examining Claims 1-18 in the same application.

Applicants will now direct their remarks to the Claims 1-9, which were examined in the outstanding Office Action. Of these claims, Claim 1 is an independent claim; the remaining claims are dependent claims. Claims 1-9 stand rejected under 35 USC § 103(a) as obvious over Hurst et al. in view of Daughton et al. Specifically the Office asserted that “[i]t would have been obvious ... to use the NiFeCo with super-paramagnetic properties for Hurst’s magnetic liner since Daughton explicitly details the advantages of such materials.” Reconsideration and withdrawal of the present rejections are hereby respectfully requested.

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A 35 USC 103(a) rejection requires that the combined cited references provide both the motivation to combine the references and an expectation of success. Not only is there no motivation to combine the references, no expectation of success, but actually combining the references would not produce the claimed invention. Thus, the claimed invention is patentable over the combined references and the state of the art.

Applicants respectfully disagree with the Office's characterizations of the disclosures of Hurst and Daughton. The Office asserts that "Hurst ... discloses that the magnetic liner (122, Fig. 16 corresponding to 30, Fig. 4) comprises a soft magnetic material formed from NiFe, NiFeCo, or CoFe or other similar materials (Col. 5, lines: 25-35 and Col. 7, lines: 5-15), however, Hurst does not explicitly disclose that the magnetic liner has super-paramagnetic properties." (*Office Action* at 3) A review of Figs. 4 and 16, however, discloses that reference numeral 122 in Fig. 16 **does not** correspond to reference numeral 30 as asserted by the Office.

In particular, as noted with reference to Fig. 4, "the deposition of the soft magnetic material layer 30 only occurs on the horizontal surfaces of the dielectric layer 10, including the bottom surface 22 of the cavity 20, and the remaining top surface 32 of the dielectric layer 10." (Col. 5, lines 19-23) As such, there is no teaching of having a soft magnetic material formed from NiFe, NiFeCo, or CoFe on the sides of the cavity 20. Fig. 16 does not overcome the deficiency of Fig. 4, as – at a minimum – there is no teaching that the magnetic material at reference numeral 122 is formed from NiFe, NiFeCo, or CoFe.

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Daughton does not overcome the deficiencies of Hurst set forth above. In that regard, there is insufficient teaching, motivation or suggestion in Hurst that a magnetic liner should or could be modified to have super-paramagnetic properties. It is only through the hindsight of the present application that such modification can be recognized. *See, e.g., In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000).

In view of the foregoing, it is respectfully submitted that independent Claim 1 fully distinguishes over the applied art and is thus allowable. By virtue of dependence from Claim 1, it is thus also submitted that Claims 2-9 are also allowable at this juncture.

The "prior art made of record" has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant as to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

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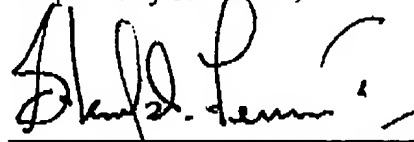
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In summary, it is respectfully submitted that the instant application, including Claims 1-9, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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